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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,136	08/24/2001	Scott T. Brown	CSP-1	2977
21833	7590	08/09/2006	EXAMINER	
PRITZKAU PATENT GROUP, LLC 993 GAPTER ROAD BOULDER, CO 80303			JEAN GILLES, JUDE	
		ART UNIT	PAPER NUMBER	2143

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/939,136	BROWN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jude J. Jean-Gilles	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 April 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-30,32-40 and 43-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 43-72 is/are allowed.
- 6) Claim(s) 1-4,13,27-30,32-40 and 73-76 is/are rejected.
- 7) Claim(s) 5-12 and 14-26 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 24 August 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

This Action is in regards to the Reply received on 04/25/2006.

### ***Response to Amendment***

1. This action is responsive to the application filed on 08/24/2001 and reply received on 04/25/2006. Claims 1-30, 32-40, and 43-76 are pending in this application. Claims 1-30, 32-40, and 43-76 represent a method and apparatus for "an email messaging System and Method for enhanced rich text delivery."

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-30, 32-40, and 43-76 have been carefully considered, are deemed persuasive in light of the prior Art of record. New prior art of Outchi U.S. patent No. 6,553,407 B1 is applied in combination with Mintz U.S. patent No. 6,250,930 B1 to show the obviousness of many claims previously anticipated by Mintz.

### ***Information Disclosure Statement***

3. The references listed on the Information Disclosure Statement submitted on 02/15/2002 have been considered by the examiner (see Mintz; see attached PTO-1449A).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(see Mintz; a) which forms the basis for all obviousness rejections set forth in this Office action:

(see Mintz; a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-4, 13, 27-30, 32-40, and 73-76** are rejected under 35 U.S.C. 103(see Mintz; a) as being unpatentable over Mintz, U.S. Patent No. 6,250,930 B1 in view of Outchi U.S. patent No. 6,553,407 B1.

**Regarding claim 1**, Mintz discloses in a multi-user e-mail messaging system interfaced through the Internet and including at least a first user group sharing at least a first server, which first server is, in turn, interfaced to the Internet such that any user of the first user group may send an e-mail message for transfer to an intended recipient selected as at least one of (see Mintz; i) another user in the first user group and (see Mintz; ii) a remote user interfaced to the Internet by a connection other than said first server (see Mintz; fig. 1 items 110, 120, and 125), a method comprising :

after said e-mail message has been originated by an originating user of the first user group, directing the e-mail message onto an e-mail enhancement path (see Mintz; column 4, lines 44-58);

However, Mintz does specifically disclose "adding additional rich media content to said e-mail message using the e-mail enhancement path to produce an enhanced e-

mail message; and thereafter, directing the enhanced e-mail message from the e-mail enhancement path to the intended recipient.

In the same field of endeavor, Bereiter discloses a method and a system in which "the workflow document is processed as follows: 1) The user at e-mail address A initiates the workflow by sending an e-mail 61 with document R and STEP=1 to the form route manager; 2) The form route manager receives the e-mail 61, and determines from STEP=1 and the route that the next e-mail address is B and the next step is 2. The form route manager updates STEP=2 and sends the workflow document R as e-mail 62 to e-mail address B; 3) The user at e-mail address B receives the e-mail 62 from the form route manager, processes the document by changing the body of the message to S, and sends e-mail 63 back to the form route manager; 4) The form route manager receives the e-mail 63, and determines from STEP=2 and the route that the next e-mail address is C and that the next step is 3. The form route manager updates STEP=3 and sends the workflow document as e-mail 64 to e-mail address C; 5) A user at e-mail address C receives the e-mail 64 from the form route manager, processes the document by changing the body to T, and sends e-mail 65 back to the form route manager; and 6) The form route manager receives the e-mail 65 and determines from STEP=3 and the route the next step is NULL which completes the route..." [see Outchi, column 5, lines 59-67; column 6, lines 11-15].

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Outchi's teachings of a method adding additional rich media content to said e-mail message using the e-mail

enhancement path to produce an enhanced e-mail message, with the enhanced e-mail within an enhancement path teachings of Mintz, for the purpose of “*to allow such multimedia-enhanced e-mail to be directly routed to a desired set of recipients without requiring such recipients to have an active connection to the Internet...*” as stated by Mintz lines 25-30 of column 2. Outchi also provides a motivation to combine by providing an e-mail based workflow system for processing a document and for centrally distributing an email ...[see Outchi ; column 2, lines 28-42]. By this rationale **claim 1** is rejected.

**Regarding claim 2, the combination Mintz-Outchi discloses the method of**  
claim 1 wherein the e-mail message onto the e-mail enhancement path includes receiving the e-mail message at said first server (see Mintz; see Mintz; column 6, lines 42-64).

**Regarding claim 3, the combination Mintz-Outchi discloses the method of**  
claim 2 wherein said receiving includes using TCP/IP socket communication (see Mintz; see Mintz; column 6, lines 42-64).

**Regarding claim 4, the combination Mintz-Outchi discloses the method of**  
claim 2 wherein said receiving direct API access (see Mintz; see Mintz; column 6, lines 42-64; column 7, lines 1-32).

**Regarding claim 13, the combination Mintz-Outchi discloses the method of**  
claim 1 wherein said directing the e-mail message onto the e-mail enhancement path

includes adding a request for additional rich media content to the e-mail message (see Mintz; see Mintz; column 6, lines 42-64).

**Regarding claim 27, the combination Mintz-Outchi discloses the method of**  
claim 1 wherein said adding additional rich media content to the e-mail message  
includes creating one or more rich media templates to serve as said additional rich  
media content (see Mintz; see Mintz; column 6, lines 42-64; column 7, lines 1-32).

**Regarding claim 28, the combination Mintz-Outchi discloses the method of**  
claim 27 wherein said creating one or more templates includes implementing a set of  
computer code compatible with the Internet, said set of computer code including  
instructions for displaying specified rich media rich media content (see Mintz; column 6,  
lines 42-64; column 7, lines 1-32).

**Regarding claim 29, the combination Mintz-Outchi discloses the method of**  
claim 28 wherein said creating one or more rich media templates further includes  
adding an insertion tag for identifying a point in said rich media template at which point  
at least a portion of said e-mail message is to be inserted into the rich media template  
(see Mintz; column 6, lines 42-64; column 7, lines 1-32).

**Regarding claim 30, the combination Mintz-Outchi discloses the method of**  
claim 28 wherein said set of computer code is in HTML (see Mintz; column 4, lines 44-  
58; column 5, lines 25-67; column 6, lines 42-64;). Also those of ordinary skill in the art  
know how to implement the disclosure of Mintz with HTML computer code.

**Regarding claim 32, the combination Mintz-Outchi discloses in a multi-user e-mail messaging system interfaced through the Internet and including at least a first user group sharing at least a first server, which first server is, in turn, interfaced to the Internet such that any user of the first user group may send an out-bound e-mail message for transfer to an intended recipient selected as at least one of (I) another user in the first user group and (ii) a remote user interfaced to the Internet by a connection other than said first server, a messaging configuration comprising:** means for adding additional rich media content to said out-bound e-mail message; means for routing said out-bound e-mail message to said means for adding additional rich media content, after said out-bound e-mail message has been originated by an originating user of the first user group, to add the additional rich media content thereby producing an enhanced e-mail message; and means for directing the enhanced e-mail message to the intended recipient (see Mintz; column 4, lines 44-58; column 5, lines 25-67; column 6, lines 42-64).

**Regarding claim 33, the combination Mintz-Outchi discloses the messaging configuration of claim 32 further comprising means for receiving an in-bound e-mail message intended for transfer to any user of the first user group (see Mintz; column 4, lines 44-58; column 5, lines 25-67; column 6, lines 42-64).**

**Regarding claim 34, the combination Mintz-Outchi discloses the messaging configuration of claim 33 wherein said receiving means includes means for routing the in-bound e-mail message to one of a plurality of processing stations (see Mintz; column 4, lines 44-58; column 5, lines 25-67; column 6, lines 42-64).**

**Regarding claim 35, the combination Mintz-Outchi discloses in a multi-user e-mail messaging system interfaced through the Internet and including at least a first user group sharing at least a first server, which first server is, in turn, interfaced to the Internet such that any user of the first user group may send an e-mail message for transfer to an intended recipient selected as at least one of (i) another user in the first user group and (ii) a remote user interfaced to the Internet by a connection other than said first server, a messaging configuration comprising:** a first arrangement for adding additional rich media content to said e-mail message; a second arrangement for receiving the e-mail message, after said e-mail message has been originated by an originating user of the first user group, and for routing the e-mail message to the first arrangement to add the additional rich media content to produce an enhanced e-mail message; and a third arrangement for directing the enhanced e-mail message from the e-mail enhancement path to the intended recipient (see Mintz; column 4, lines 44-58; column 5, lines 25-67; column 6, lines 42-64; see Outchi, *column 5, lines 59-67; column 6, lines 11-15*).

**Regarding claim 36, the combination Mintz-Outchi discloses the in a multi-user e-mail messaging system interfaced through the Internet and including at least a first user group sharing at least a first server, which first server is, in turn, interfaced to the Internet such that any user of the first user group may send an e-mail message for transfer to an intended recipient selected as at least one of (i) another user in the first user group and (ii) a remote user interfaced to the Internet by a connection other than said first server, a messaging configuration comprising:** a first auxiliary server for

directing the e-mail message to a first location, after said e-mail message has been placed en route to the intended recipient; and at the first location, a second auxiliary server for adding additional rich media content to said e-mail message to produce an enhanced e-mail message and, thereafter, for directing the enhanced e-mail message to the intended recipient (see Mintz; column 4, lines 44-58; column 5, lines 25-67; column 6, lines 42-64; see Outchi, *column 5, lines 59-67; column 6, lines 11-15*).

**Regarding claim 37, the combination Mintz-Outchi discloses the messaging configuration of claim 36 wherein said first auxiliary server is configured for receiving an in-bound e-mail message intended for transfer to any user of the first user group (see Mintz; column 4, lines 44-58; column 5, lines 25-67; column 6, lines 42-64).**

**Regarding claim 38, the combination Mintz-Outchi discloses the messaging configuration of claim 37 wherein said first auxiliary server includes means for routing the in-bound e-mail message to one of a plurality of processing stations (see Mintz; column 4, lines 44-58; column 5, lines 25-67; column 6, lines 42-64).**

**Regarding claim 39, the combination Mintz-Outchi discloses in a multi-user e-mail messaging system interfaced through the Internet and including at least a first user group sharing at least a first server, which first server is, in turn, interfaced to the Internet such that any user of the first user group may send an e-mail message for transfer to an intended recipient selected as at least one of (i) another user in the first user group and (ii) a remote user interfaced to the Internet by a connection other than said first server, said system further defining an in-coming e-mail message path to each user of the first user group from the first server at least for receiving an external e-mail**

message originating outside the first user group and directed to one or more of the users of the first user group, an e-mail message enhancement configuration comprising: an out-going e-mail message path configured for enhancing an out-going e-mail message originated by any user in said first user group, said out-going e-mail message path being defined at least in part between the first server and each user of the first user group, and including at least one different node as compared to the incoming e-mail message path said outgoing e-mail message path including an e-mail enhancement path for receiving said e-mail message after said email message has been originated by an originating user of the first user group and for adding additional rich media rich media content to the e-mail message thereby producing an enhanced e-mail message (see Mintz; column 4, lines 44-58; column 5, lines 25-67; column 6, lines 42-64; see Outchi, *column 5, lines 59-67; column 6, lines 11-15*).

**Regarding claim 40, the combination Mintz-Outchi discloses the e-mail message enhancement configuration of claim 39 wherein said out-going e-mail message path includes a second server located at said different node (see Mintz; column 4, lines 44-58; column 5, lines 25-67; column 6, lines 42-64).**

**Regarding claim 73, the combination Mintz-Outchi discloses in a multi-user e-mail messaging system interfaced through the Internet and including at least a first user group sharing at least a first server, which first server is, in turn, interfaced to the Internet such that any user of the first user group may send an e-mail message for transfer to an intended recipient selected as at least one of (i) another user in the first**

user group and (ii) a remote user interfaced to the Internet by a connection other than said first server, an enhancement server comprising: means for receiving the e-mail message, after the e-mail message has been placed en route to the intended recipient; means for adding additional rich media content to said e-mail message to produce an enhanced e-mail message; and thereafter, means for rerouting the enhanced e-mail message to the intended recipient (see Mintz; column 4, lines 44-58; column 5, lines 25-67; column 6, lines 42-64; see Outchi, *column 5, lines 59-67; column 6, lines 11-15*).

**Regarding claim 74, the combination Mintz-Outchi discloses a computer program arrangement in a computer readable medium for use in a multi-user e-mail messaging system interfaced through the Internet and including at least a first user group sharing at least a first server, which first server is, in turn, interfaced to the Internet such that any user of the first user group may send an e-mail message for transfer to an intended recipient selected as at least one of (i) another user in the first user group and (ii) a remote user interfaced to the Internet by a connection other than said first server, said computer program arrangement comprising:** first instructions for receiving the e-mail message, after the e-mail message has been originated by an originating user of the first user group; second instructions for adding additional rich media content to said e-mail message to produce an enhanced e-mail message; and third instructions for rerouting the enhanced e-mail message to the intended recipient (see Mintz; column 4, lines 44-58; column 5, lines 25-67; column 6, lines 42-64; see Outchi, *column 5, lines 59-67; column 6, lines 11-15*).

**Regarding claim 75, the combination Mintz-Outchi discloses the method of**  
claim 1 wherein said e-mail message includes a body, which contains a portion of the e-Mail message viewable by the originating user, and wherein said adding additional rich media content includes adding additional rich media content to the body of said e-mail message (see Mintz; column 4, lines 44-58; column 5, lines 25-67; column 6, lines 42-64).

**Regarding claim 76, the combination Mintz-Outchi discloses the messaging configuration of claim 32 wherein said out-bound e-mail message includes a body, and wherein said means for adding additional rich media content includes means for adding said additional rich media content to the body of said message (see Mintz; column 4, lines 44-58; column 5, lines 25-67; column 6, lines 42-64).**

***Allowable Subject Matter***

6. **Claims 5-12, and 14-26** objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Allowed claims***

7. **Claims 43-72** have been allowed.

***Response to Arguments***

8. Applicant's Request for Reconsideration filed on 04/25/2006 has been carefully considered but is deemed persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address Applicants' main points of contention.

A. Regarding the 35 U.S.C. paragraph 102 rejections, Applicants submit that the Mintz patent does not teach every element of the claims and that Mintz fail to specifically teach how the functionality of implementing the enhanced path is implemented. Applicants continue to mention that the enhancement path of the present invention included a process that contains a routing application with a processing application for selective addition of rich media content to outbound messages. Applicants contend further that the cited portion of Mintz do not provide the direction of the email message to and email message in order to produce enhanced email message as described in the application.

B. Regarding the 35 U.S.C. paragraph 103 rejections over Mintz in view of Bereiter, applicants contend that the obviousness rejections must be withdrawn.

As to "Point A" the 35 U.S.C. paragraph 102 rejections have been withdrawn. However new patent of Outchi teaches the enhancement path as described in the present invention including a process that contains a routing application with a processing application for selective addition of rich media content to outbound messages (see rejection of claim 1 above).

As to "Point B", all claims previously rejected have been allowed.

Examiner notes with delight that no new matter has been added and that the new claims are supported by the application as filed.

***Conclusion***

8. **THIS ACTION IS MADE NON-FINAL.** Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-9000.

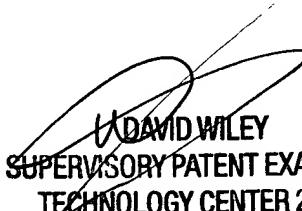
Jude Jean-Gilles

Patent Examiner

Art Unit 2143

JJG

July 26, 2006

  
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